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BLAKELY SOKOLOFF TAYLOR & ZAFMAN/PDC
12400 WILSHIRE BOULEVARD
SEVENTH FLOOR
LOS ANGELES, CA 90025

In re Application of:	:	
MOCHI, Gianni, et al.	:	DECISION ON PETITIONS
U.S. Application No.: 10/540,374	:	UNDER 37 CFR 1.137(b) AND
Int'l Application No: PCT/EP2003/014559	:	37 CFR 1.47(a)
Int'l Filing Date: 18 December 2003	:	
Priority Date: 23 December 2002	:	
Atty Docket No.: 6097P066	:	
For: SYSTEM FOR ESTIMATION AND	:	
CONTROL OF CONCENTRATIONS OF:	:	
POLLUTANT GASES AT THE	:	
DISCHARGE OF A GAS TURBINE	:	

This decision is issued in response to the Petition for Revival under 37 CFR 1.137(b) filed 19 October 2007 and the "Petition For Filing By Other Than All The Inventors Under 37 CFR 1.47(a)" filed 19 October 2007 and supplemented on 30 November 2007. Applicants have paid the required petition fees.

BACKGROUND

On 18 December 2003, applicants filed international application PCT/EP2003/014559. The application claimed an earlier priority date of 23 December 2002 and it designated the United States. On 08 July 2004, the International Bureau (IB) communicated a copy of the international application to the United States Patent and Trademark Office (USPTO). The deadline for filing the basic national fee was thirty months from the priority date, i.e., 23 June 2005.

On 22 June 2005, applicants filed a Transmittal Letter requesting entry into the U.S. national stage, accompanied by, among other materials, payment of the basic national fee.

On 27 December 2005, the United States Designated/Elected Office (DO/EO/US) mailed a Notification Of Missing Requirements (Form PCT/DO/EO/905) indicating that an oath or declaration in compliance with 37 CFR 1.497 and the surcharge for filing the oath or declaration later than thirty months after the priority date were required. The Notification set forth an extendable two month response period.

Applicants did not file a response to the Notification Of Missing Requirements during the extendable time period. Accordingly, this application became abandoned at midnight on 27 February 2006.

On 19 October 2007, applicants filed the Petition for Revival under 37 CFR 1.137(b) and the "Petition For Filing By Other Than All The Inventors Under 37 CFR 1.47(a)" considered herein. The petition under 37 CFR 1.47(a) seeks acceptance of the application without the signature of non-signing inventor Luciano BONCIANI, whom applicants assert cannot be located after diligent effort.

On 30 November 2007, applicants filed a supplement to the petition under 37 CFR 1.47(a) that included a declaration executed by the previously non-signing inventor.

DISCUSSION

37 CFR 1.137(b) permits the filing of a petition to revive an abandoned application where the abandonment resulted from an unintentional delay. A grantable petition under this section must include: (1) the required reply, unless previously filed; (2) the petition fee required by law; (3) a statement that the "entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unintentional;" and (4) any terminal disclaimer and fee required pursuant to 37 CFR 1.137(c). It is noted that item (4) does not apply to the present application.

With respect to item (1), the "required reply" in this application is a proper response to the Notification Of Missing Requirements mailed 27 December 2005, that is, an acceptable oath or declaration and the required surcharge payment. Applicants' 19 October 2007 submission included the surcharge payment, a declaration executed by four of the five inventors, and the petition under 37 CFR 1.47(a) requesting acceptance of the declaration without the signature of the remaining inventor. Applicants' supplemental submission filed 30 November 2007 included a declaration executed by the previously non-signing inventor. The 30 November 2007 submission renders the previously filed petition under 37 CFR 1.47(a) moot.

Based on the above, applicants have now submitted the required surcharge payment and a declaration executed by all the inventors. The declaration satisfies the requirements of 37 CFR 1.497. Accordingly, applicants have provided the "required reply." Item (1) is satisfied.

With respect to item (2), applicants have submitted the required petition fee. Item (2) is therefore satisfied.

The present petition fails, however, to satisfy item (3) above. The petition includes general statements that "the entire delay in filing the required reply from the due date for the required reply until the filing of a grantable petition under 37 CFR 1.137(b) was unintentional" and that "[t]he delay in the reply by Applicant was unintentional." However, no petition under 37 CFR 1.137(b) was filed within one year of the date of abandonment of the present application; under such circumstances, there is a question whether the delay was unintentional. *See* MPEP section 711.03(c)(II)(D); *see also Changes to Patent Practice and Procedure; Final*

Rule Notice, 62 *Fed. Reg.* at 53158-59 (October 10, 1997), 1203 *Off. Gaz. Pat. Office* at 86-87 (October 21, 1997). Where there is a question whether the delay was unintentional, the petitioner must meet the burden of establishing that the delay was unintentional within the meaning of 35 U.S.C. § 41(a)(7) and 37 CFR 1.137(b). See *In re Application of G*, 11 USPQ2d 1378, 1380 (Comm'r Pats. 1989). As set forth in MPEP section 711.03(c)(II)(D), there are three periods of delay to consider in determining whether the entire delay from the due date for the required reply until the filing of a grantable petition for revival was unintentional: (A) the delay in reply that resulted in the original abandonment; (B) the delay in filing an initial petition for revival; and (C) the delay in filing a grantable petition for revival.

In addition to the fact that the petition was filed more than one year after the date of abandonment, there are specific items in the present record that raise questions as to whether the entire relevant delay herein was unintentional. For example, an attached email from counsel's assistant dated 16 August 2006 indicates that applicant was aware at that time of being "up against" the extendable deadline to respond to the Notification Of Missing Requirements, yet the petitions under 37 CFR 1.137(b) and 1.47(a) were not filed until more than one year later.¹ In addition, an attached email from counsel dated 06 February 2007 indicates that counsel was aware at such time that the present application was abandoned, and it states that counsel was waiting until receiving signed forms before filing a petition for revival. This email implies that the delay from at least 06 February 2007 until the filing of the petition for revival more than eight months later was deliberate (see MPEP section 711.03(c)(II)(D): "where the applicant deliberately chooses to delay seeking the revival of an abandoned application, the resulting delay in seeking revival of the abandoned application cannot be considered as 'unintentional' within the meaning of 37 CFR 1.137(b)").

In view of the above, there is a question here whether the delay in prosecution, as well as the delay in seeking revival, was unintentional. Therefore, in addition to the statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional, applicants must provide a showing as to: (1) the date that applicants (or applicants' representative) first became aware of the abandonment of the application; (2) how any delay between the abandonment and applicants' (or applicants' representatives) discovery of the abandoned status of the application occurred; and (3) the cause of any delay between applicants' (or applicants' representatives) discovery of the abandoned status of the application and the filing of a petition to revive. See 37 CFR 1.137(b)(3).

Further, any renewed petition should include copies of any correspondence or communications between counsel and applicants and/or the assignee, which would rebut any inference that the filing of the petition to revive was intentionally delayed. This showing should include, but is not limited to, docket records, tickler reports, and file jacket entries for this application.

Based on the above, applicants have not, on the present record satisfied item (3) of a grantable petition for revival under 37 CFR 1.137(b). Accordingly, revival of the application is not appropriate at this time.

¹ It is noted that the extendable response period had already expired at the time of this email.

CONCLUSION

The petition for revival under 37 CFR 1.137(b) is **DISMISSED** without prejudice.

The petition under 37 CFR 1.47(a) is **DISMISSED AS MOOT** based on applicants' submission of a declaration executed by the previously non-signing inventor.

If reconsideration on the merits of the petition for revival is desired, a proper response must be filed within **TWO (2) MONTHS** from the mail date of this decision. Any request for reconsideration should be entitled "Renewed Petition Under 37 CFR 1.137(b)" and it must include the materials required to satisfy the outstanding requirement of 37 CFR 1.137(b)(3), as discussed above and in the MPEP.

No additional petition fee is required. Extensions of time may be obtained under 37 CFR 1.136(a).

Any further correspondence with respect to this matter should be addressed to the Mail Stop PCT, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration



Richard M. Ross
Attorney Advisor
Office of PCT Legal Administration
Telephone: (571) 272-3296
Facsimile: (571) 273-0459